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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

MARKETO, INC.,

Plaintiff,

v.

JOHN DOE,

Defendant.

Case No.18-cv-06792-JSC

**ORDER RE: EX PARTE MOTION FOR
EARLY DISCOVERY**

Re: Dkt. No. 5

Plaintiff Marketo, Inc., a software company, alleges that Doe Defendant is using the Marketo Marks or similar variations thereof without authorization to sell email templates online. Now pending before the Court is Plaintiff's ex parte motion to for early discovery. (Dkt. No. 5.¹) Specifically, Plaintiff seeks permission to issue a subpoena to third-party Namecheap, Inc. which is the domain registrar associated with omgdownload.com, the website marketing the allegedly infringing email templates. Having considered Plaintiff's arguments and the relevant authority, the Court GRANTS the motion.

BACKGROUND

Plaintiff is a software company focused on account-based marketing, including email, mobile, social, digital ads, web management, and analytics. Plaintiff has used the "Marketo" Mark since 2006 to identify its company and products. It owns the MARKETO Mark, U.S. Registration Nos. 3,369,973 and 4,331,015. (Dkt. No. 6 at ¶ 2.)

Recently, Plaintiff discovered that Defendant was using the Marketo Mark to sell email templates that are downloaded on the Internet through the website omgdownload.com. (*Id.* at ¶¶

¹ Record citations are to material in the Electronic Case File ("ECF"); pinpoint citations are to the ECF-generated page numbers at the top of the documents.

1 3-4; Dkt. No. 6-1.) Plaintiff has not authorized this sale and is unaware of Defendant's true
2 identity. (Dkt. No. 6 at ¶ 3.) On September 12, 2018, Plaintiff contacted Namecheap, Inc. the
3 domain name registrar for the omgdownload.com website asking that it request the owner of the
4 site to take down the pages using the Marketo Mark. (Dkt. No. 6 at ¶ 4; Dkt. No. 6-2.)
5 Namecheap responded that it "cannot force our customer to remove the reported content as
6 containing a registered trademark" under the Digital Millennium Copyright Act and that Plaintiff
7 should "resolve such issues via submitting a dispute to the Court of competent jurisdiction as it
8 leads to the most efficient and competent settlement." (Dkt. No. 6 at ¶ 5; Dkt. No. 6-3.)
9 Namecheap also stated that it would forward the complaint to the customer. (Dkt. No. 6-3.)

10 Plaintiff thereafter filed this action alleging that John Doe was infringing on its Marketo
11 trademark, as well as alleging claims for false advertising and unfair competition. (Dkt. No. 1.)
12 Plaintiff's complaint was accompanied by the underlying ex parte application to conduct early
13 discovery of Namecheap to determine Joe Doe's true identity.

14 **LEGAL STANDARD**

15 Federal Rule of Civil Procedure 26(d)(1) requires a court order for discovery if it is
16 requested prior to a Rule 26(f) conference between the parties. *See Fed. R. Civ. P. 26(d)(1)* ("A
17 party may not seek discovery from any source before the parties have conferred as required by
18 Rule 26(f), except . . . by court order."). In fashioning Rule 26(d) discovery orders, the district
19 court wields broad discretion. *See Laub v. U.S. Dep't of Interior*, 342 F.3d 1080, 1093 (9th Cir.
20 2003).

21 Courts within the Ninth Circuit apply a "good cause" standard to determine whether to
22 permit such early discovery. *See Semitool, Inc. v. Tokyo Electron Am., Inc.*, 208 F.R.D. 273, 276
23 (N.D. Cal. 2002); *see also G.N. Iheaku & Co. v. Does 1-3*, No. C-14-02069 LB, 2014 WL
24 2759075, at *2 (N.D. Cal. June 17, 2014) (collecting cases). "Good cause may be found where the
25 need for expedited discovery, in consideration of the administration of justice, outweighs the
26 prejudice of the responding party." *Id.*

27 When the identities of defendants are not known before a complaint is filed, a plaintiff
28 "should be given an opportunity through discovery to identify the unknown defendants, unless it is

1 clear that discovery would not uncover the identities, or that the complaint would be dismissed on
2 other grounds.” *Gillespie v. Civiletti*, 629 F.2d 637, 642 (9th Cir. 1980). To determine whether
3 there is “good cause” to permit expedited discovery to identify doe defendants, courts commonly
4 consider whether:

5 (1) the plaintiff can identify the missing party with sufficient
6 specificity such that the Court can determine that defendant is a real
7 person or entity who could be sued in federal court; (2) the plaintiff
8 has identified all previous steps taken to locate the elusive defendant;
9 (3) the plaintiff’s suit against defendant could withstand a motion to
dismiss; and (4) the plaintiff has demonstrated that there is a
reasonable likelihood of being able to identify the defendant
through discovery such that service of process would be possible.

10 *OpenMind Solutions, Inc. v. Does 1-39*, No. 11-3311, 2011 WL 4715200, at *2 (N.D. Cal. Oct. 7,
11 2011) (citing *Columbia Ins. Co. v. seescandy.com*, 185 F.R.D. 578-80 (N.D. Cal. 1999)).

12 DISCUSSION

13 Plaintiff has made a sufficient showing under all four factors to establish good cause for
14 expedited discovery.

15 Under the first factor, “the Court must examine whether the Plaintiff has identified the
16 Defendants with sufficient specificity, demonstrating that each Defendant is a real person or entity
17 who would be subjected to jurisdiction in this Court.” *Pac. Century Int’l, Ltd. v. Does 1-48*, No.
18 11-3823, 2011 WL 4725243, at *2 (N.D. Cal. Oct. 7, 2011). Plaintiff has done so. Specifically,
19 Plaintiff alleges that the Doe Defendant owns or is using the domain name omgdownload.com to
20 sell email templates using the Marketo Mark. (Dkt. No. 1 at ¶ 10.)

21 Under the second factor, the party should identify all previous steps taken to locate the
22 elusive defendant. *Columbia Ins. Co.*, 185 F.R.D. at 579. “This element is aimed at ensuring that
23 plaintiffs make a good faith effort to comply with the requirements of service of process and
24 specifically identifying defendants.” *Id.* Here, Plaintiff contacted Namecheap, the domain name
25 registrar, and asked that the information be taken down, but Namecheap responded by refusing to
26 do so. (Dkt. No. 6-2; Dkt. No. 6-3.) The domain name is not sufficient for Plaintiff to identify the
27 Doe Defendant, and Plaintiff has no other means to identify the Doe Defendant besides
28 Namecheap’s record which it refuses to provide without a subpoena. (See Dkt. No. 5 at 4-5.)

1 Plaintiff has therefore satisfied the second element.

2 Under the third requirement, a plaintiff must establish to the court's satisfaction that the
3 complaint can withstand a motion to dismiss. *See Columbia Ins. Co.*, 185 F.R.D. at 579. Plaintiff
4 has done so. To state a claim for trademark infringement claim under the Lanham Act, plaintiff
5 must show that: (1) it has valid, protectable trademark, and (2) defendant's use of mark is likely to
6 cause confusion. *See S. California Darts Ass'n v. Zaffina*, 762 F.3d 921 (9th Cir. 2014) (citing 15
7 U.S.C.A. § 1125(a)). Plaintiff has made this showing by alleging that it holds a valid trademark
8 for the Marketo Mark and that the Doe Defendant is using that Mark to sell products on the
9 omgdownload.com website. (Dkt. Nos. 1-1; 1-2; 1-3.)

10 The final factor concerns whether the discovery sought will uncover the identity of the Doe
11 Defendant. *See Gillespie*, 629 F.2d at 642-43 (stating that early discovery to identify doe
12 defendants should be allowed "unless it is clear that discovery would not uncover the identities").
13 Plaintiff alleges that Namecheap is the domain registrar for omgdownload.com and that it has
14 stated that it would pass the complaint information on to the website owner. (Dkt. No. 5 at 5.)
15 Plaintiff has thus demonstrated that a subpoena on Namecheap should reveal the identity of the
16 Doe Defendant.

17 Ultimately, granting early discovery to permit Plaintiff to identify the Doe Defendant
18 appears to be the only way to advance this litigation. *See UMG Recordings, Inc. v. Doe*, No. C
19 08-1193 SBA, 2008 WL 4104215, at *4 (N.D. Cal. Sept. 3, 2008) (citation omitted). Moreover,
20 there is no prejudice to Doe Defendant in granting the requested early discovery because it is
21 narrowly tailored to seek only their identity." *Id.* (citations omitted). Plaintiff has therefore met
22 its burden of establishing good cause for early discovery.

23 CONCLUSION

24 For the reasons stated above, the Court GRANTS Plaintiff's motion for early discovery.
25 (Dkt. No. 5.) Plaintiff shall file a proposed subpoena and proposed order consistent with Civil
26 Local Rule 7-2(c) by November 28, 2018. Once the Court approves the subpoena, Plaintiff may
27 serve it on Namecheap.

28 This Order disposes of Docket No. 5.

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2 **IT IS SO ORDERED.**

3 Dated: November 19, 2018

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Jacqueline Scott Corley
JACQUELINE SCOTT CORLEY
United States Magistrate Judge